

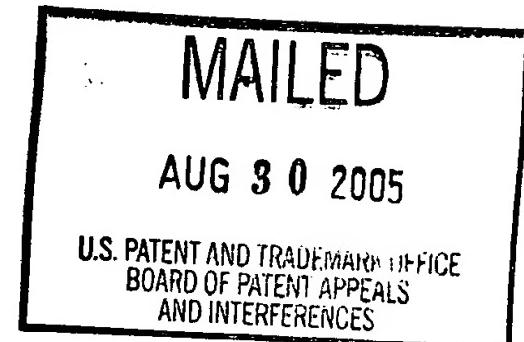
The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte COLIN ANTHONY KEMP

Appeal No. 2005-2056
Application No. 09/601,106



ON BRIEF

Before SCHEINER, GRIMES, and GREEN, Administrative Patent Judges.

GRIMES, Administrative Patent Judge.

DECISION ON APPEAL

This appeal involves claims to a composition for treating erectile dysfunction.

The examiner has rejected the claims as indefinite and unpatentable over the prior art.

We have jurisdiction under 35 U.S.C. § 134. We affirm.

Background

The specification discloses that "nitroglycerin (glyceryl trinitrate) can be used as a vasodilator in a composition for topical application . . . for the treatment of erectile dysfunction." Page 2. "The glyceryl trinitrate acts as a vasodilator according to its established utility for example in the treatment of angina pectoris but it has not hitherto been recognised that in simple combination with lanolin there could be provided an effective treatment of erectile dysfunction in human males." Pages 3-4.

“Glyceryl trinitrate is a material which is per se explosive. For use in the present invention, it is preferably adsorbed on a solid stabilizer in finely-divided particulate form. . . . A preferred stabilizer compound is lactose on which the glyceryl trinitrate may be adsorbed at a concentration of from 5 to 20% by weight, for example 10% by weight. Glyceryl trinitrate is preferably present in a concentration up to 5% by weight of the overall formulation; a concentration of 1% or 2% by weight is generally sufficient to be effective.”

Discussion

1. Claim construction

The claims subject to each rejection stand or fall together. See the Appeal Brief, page 5. We will focus on claim 24, the broadest claim on appeal. Claim 24 reads as follows:

24. A composition for the treatment of erectile dysfunction in human males, the composition comprising a mixture of effective amounts of glyceryl trinitrate and lanolin and also containing water.

Thus, claim 24 is directed to a composition comprising lanolin, water, and an effective amount of glyceryl trinitrate. The specification states that 1% by weight is an exemplary effective amount.

The preamble of claim 24 states that the composition is “for the treatment of erectile dysfunction in human males.” “If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim.” Pitney Bowes Inc. v. Hewlett Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). “Where . . . a patentee defines a structurally complete invention in the claim body and uses the

preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation.” Rowe v. Dror, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997).

In this case, the preamble merely states the intended use of the claimed composition. The preamble’s statement that the composition is intended “for the treatment of erectile dysfunction in human males” does not add any further limitations to those recited in the body of the claim. “If the preamble adds no limitations to those in the body of the claim, the preamble is not itself a claim limitation and is irrelevant to proper construction of the claim.” IMS Technology, Inc. v. Haas Automation, Inc., 206 F.3d 1422, 1434, 54 USPQ2d 1129, 1137 (Fed. Cir. 2000). Therefore, we interpret claim 24 as encompassing compositions comprising, for example, 1% glyceryl trinitrate, lanolin, and water.

2. Definiteness

The examiner rejected claims 25-29 as indefinite. Claim 25 reads as follows: “A cosmetic product comprising the composition of claim a mixture of effective amounts of glyceryl trinitrate and lanolin and also containing water.” Claims 26-29 depend on either of claims 24 or 25. We agree with the examiner that claim 25 as written is indefinite.

Appellants argue that “[t]he rejection of claims 25-29 under 35 USC 112, 2d paragraph, should be reversed since claim 25 recites all the ingredients present in the inventive composition.” Appeal Brief, page 9.

We disagree with Appellants’ reasoning. The “inventive composition” is the composition defined by the claims. Since claim 25 is apparently meant to depend from, and thereby incorporate the limitations of, another claim, but fails to specify which claim it depends from, it does not fully specify the ingredients of the claimed product. Those

skilled in the art therefore cannot determine the metes and bounds of the claim. The rejection under 35 U.S.C. § 112, second paragraph, is affirmed.

3. Prior art

The examiner rejected claims 24-28 on the basis that they were either anticipated by or obvious in view of "JP 61286327 (Abstract)."¹ Examiner's Answer, page 3. The examiner also rejected claims 24-29 as obvious in view of "JP 61286327 (Abstract) in view of Heaton et al."² Id.

The relied-upon abstract reads, in its entirety, as follows:

A topical pharmaceutical contains a small amt. of nitroglycerin for accelerating peripheral blood circulation and skin respiration. Thus, an ointment was prep'd. consisting of nitroglycerin 10, lactose 90, 25% H₂O-contg. lanolin 600, and white Vaseline to 1000 g. The efficacy for treating frostbite in rats was demonstrated.

The examiner construed the abstract to mean that "the ointment contains 10 grams of nitroglycerin, 90 grams of lactose, 600 grams of lanolin of which 25% is water, and Vaseline up to 1000 grams," Office action mailed Jan. 28, 2004, page 3, and therefore anticipated or made obvious the claimed composition.

The examiner's decision to rely on an abstract when the underlying document is also prior art is contrary to Office-approved practice. See the memorandum from Stephen Kunin, then-Deputy Commissioner for Patent Examination Policy, dated April 29, 2002 (copy attached).

¹ The reference relied on by the examiner is Chem. Abstracts, Vol. 107, abstract no. 46300 (1987), which provides an abstract of Japanese patent number 61286327.

² Heaton et al., "Topical glyceryltrinitrate causes measurable penile arterial dilation in impotent men," Journal of Urology, Vol. 143, pp. 729-732 (1990).

The examiner's error, however, is harmless in this case, since a translation of the full-text Japanese patent confirms the examiner's interpretation of the abstract.³ See page 5 of the translation: Example 1 describes an ointment containing 100 g of "Nitroglycerine lactose 10 times dispersion", 600 g of "25% water-added lanolin", and "white vaseline" to 1000 g. We agree with the examiner that this description reasonably appears to describe a composition containing 10 grams of nitroglycerin (1% by weight in a 1000 gram composition), lanolin, and water. The disclosed composition therefore appears to meet all the limitations of claim 24.

Appellants argue that

[s]ince the Abstract utilizes percentages, i.e., "25%", and amounts, i.e., "1000 g", to define the quantities of two of the ingredients disclosed, i.e., amount of H₂O in the lanolin and amount of vaseline®, respectively, in the composition, it is impossible to ascertain the exact nature of the composition disclosed.

. . . There is no basis in the reference itself, given the above-noted confusing and inconsistent use of values for the various numerical recitations therein, for the values arbitrarily assigned by the Examiner.

Appeal Brief, pages 5-6.

We are not persuaded by this argument. The examiner's interpretation of the abstract is reasonable and is confirmed by the translation of the full-text patent. The reference reasonably appears to disclose, in a manner that would have been understood by those skilled in the art, a composition within the scope of claim 24.

Appellants have not shown either that the claimed composition differs from that disclosed in the prior art or that the reference is nonenabling because those skilled in the art would not have been able to make the composition described.

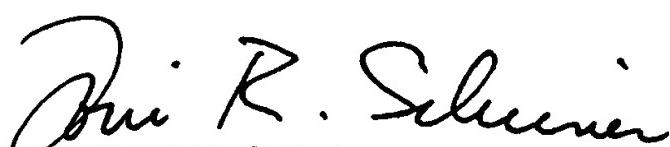
³ The examiner attached a copy of the full-text Japanese patent and a translation thereof to the Examiner's Answer. Appellants had the option of filing a Reply Brief to address the full-text document and translation but did not do so. Therefore, we see no reason to remand the application to the examiner.

Summary

We affirm the rejection of claim 24 as anticipated by the Japanese patent abstract. For the same reason, we affirm the rejection of claim 24 as obvious in view of the Japanese patent abstract, combined with Heaton. “[A]nticipation is the epitome of obviousness.” Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983). Claims 25-29 fall with claim 24. We also affirm the rejection of claims 25-29 as indefinite.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED


Toni R. Scheiner

Administrative Patent Judge



Eric Grimes
Administrative Patent Judge


Lora M. Green

Administrative Patent Judge

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